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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,343	02/05/2004	Michael Landau	59149-8004.US01	5313
22918	7590	11/08/2007	EXAMINER	
PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026			SHAW, PELING ANDY	
		ART UNIT	PAPER NUMBER	
		2144		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/774,343	LANDAU ET AL.
	Examiner	Art Unit
	Peling A. Shaw	2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 July 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-38 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 February 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. This application has no priority claim made. The filing date is 02/05/2004.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Aoki (US 7224778 B2), hereinafter referred as Aoki.

- a. Regarding claim 1, Aoki disclosed a method for managing opt-out or unsubscribe information (Fig. 1, item 42; column 5, line 40-column 6, line 3: double opt-out confirmation on canceling subscription) comprising collecting an e-mail address and contextual information for a user (column 5, lines 27-39: listing of approved message sources maintained for each individual destination user address along with predetermined parameters); storing the e-mail address and contextual information in a database (column 5, lines 11-26: subscription database); processing the e-mail address and contextual information for rule-based and learning-based use (column 4, lines 45-54: filter rules provided; 1st paragraph on page 7 of applicant's specification);

and distributing or sharing the e-mail address and contextual information, and derived processed data to an entity entitled to such information, at intervals or upon request (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating approved list; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users; column 5, lines 27-39: controlled or periodically updated).

- b. Regarding claim 2, Aoki disclosed a method as recited in claim 1, wherein the act of collecting opt-out or unsubscribe e-mail information includes: input from a plurality of sources, including HTML form inputs, HTTP links, bulk text-file import, or other input mechanisms (column 6, lines 35-42: Web page, email).
- c. Regarding claim 3, Aoki disclosed a method as recited in claim 1, further including: configuring the act of collecting opt-out or unsubscribe e-mail information (column 6, lines 35-42: subscription manager and associated database automatically assures coordinated update, messaging among service provider, partner and subscriber).
- d. Regarding claim 4, Aoki disclosed a method as recited in claim 1, further including: selecting a distribution method from a plurality of methods including File Transport Protocol (FTP), E-mail, Hypertext Transfer Protocol (HTTP), Graphical User Interface (GUI), or other network transport mechanism (column 3, lines 42-51: service provider provide subscription-type message; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users; column 6, lines 35-42: Web page, email).

Art Unit: 2144

- e. Regarding claim 5, Aoki disclosed a method as recited in claim 1, further including:
 - utilizing the database and processing mechanisms to conform to legal standards or best practices for e-mail marketing (column 5, lines 11-26: subscription database; line 40-column 6, line 3: double opt-out confirmation on canceling subscription; column 6, lines 35-42: subscription manager and associated database assures coordinated update, messaging among service provider, partner and subscriber).
- f. Regarding claim 6, Aoki disclosed a method as recited in claim 5, further including:
 - configuring the definition of "legal standards" or "best practices" (column 6, lines 35-42: subscription manager and associated database assures coordinated update, messaging among service provider, partner and subscriber; line 40-column 6, line 3: double opt-out confirmation on canceling subscription).
- g. Regarding claim 7, Aoki disclosed a method as recited in claim 1, further including:
 - utilizing the database and processing mechanisms to modify, update, or delete opt-out or unsubscribe information (column 1, lines 58-63: maintain and update subscription database; column 7, lines 34-38: subscription cancellation form).
- h. Regarding claim 8, Aoki disclosed a method as recited in claim 1, further including:
 - utilizing the database and processing mechanisms for real-time "DO NOT E-MAIL" queries (column 5, lines 11-26: subscription database and rule database used in screening out unauthorized broadcast messages).
- i. Regarding claim 9, Aoki disclosed a method as recited in claim 1, further including:
 - utilizing the database and processing mechanisms to synchronize information with external sources of opt-out or unsubscribe information (column 3, lines 42-51: service

provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provider, message source partner and recipient users).

- j. Regarding claim 10, Aoki disclosed a method as recited in claim 1, further including: utilizing the database and processing mechanisms to synchronize information with external recipients of opt-out or unsubscribe information (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provider, message source partner and recipient users).
- k. Regarding claim 11, Aoki disclosed a method as recited in claim 1, further including: utilizing the database and processing mechanisms to collect, store, process and distribute opt-in or subscription information (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provider, message source partner and recipient users; column 7, lines 34-38: subscription start form).
- l. Regarding claim 12, Aoki disclosed a method as recited in claim 1, further including: utilizing the database and processing mechanisms for e-mail list "cleaning" of addresses to be removed (column 6, lines 35-42: subscription manager and associated

database assures coordinated update, messaging among service provider, partner and subscriber; column 7, lines 34-38: subscription cancellation form).

- m. Regarding claim 13, Aoki disclosed a system for managing opt-out or unsubscribe information (Fig. 1, item 42; column 5, line 40-column 6, line 3: double opt-out confirmation on canceling subscription) comprising: means for collecting an e-mail address and contextual information for a user (column 5, lines 27-39: listing of approved message sources maintained for each individual destination user address along with predetermined parameters); means for storing the e-mail address and contextual information in a database (column 5, lines 11-26: subscription database); means for processing the e-mail address and contextual information for rule-based and learning-based use (column 4, lines 45-54: filter rules provided; 1st paragraph on page 7 of applicant's specification); and means for distributing or sharing the e-mail address and contextual information, and derived processed data to an entity entitled to such information, at intervals or upon request (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating approved list; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users; column 5, lines 27-39: controlled or periodically updated).
- n. Regarding claim 14, Aoki disclosed a system as recited in claim 13, wherein said opt-out or unsubscribe system is a sub-system of a system which also sends e-mail (Fig. 1, items 22 and 32: mail server, mail subscription manager; column 5, lines 11-26: send outbound messages via 32 and 22).

Art Unit: 2144

- o. Regarding claim 15, Aoki disclosed a system as recited in claim 13, wherein said opt-out or unsubscribe system is a sub-system of a system which also provides e-mail list management functions (Fig. 1, items 22 and 32: mail server, mail subscription manager; column 5, lines 27-39: listing of approved message sources maintained for each individual user by subscription manager).
- p. Regarding claim 16, Aoki disclosed a system as recited in claim 13, further comprising means for collecting opt-out or unsubscribe e-mail information from a plurality of sources, including HTML form inputs, HTTP links, bulk text-file import, or other input mechanisms (column 6, lines 35-42: Web page, email).
- q. Regarding claim 17, Aoki disclosed a system as recited in claim 13, further comprising means to configure the method for collection of opt-out or unsubscribe e-mail information (column 6, lines 35-42: subscription manager and associated database automatically assures coordinated update, messaging among service provider, partner and subscriber).
- r. Regarding claim 18, Aoki disclosed a system as recited in claim 13, further comprising means to select a distribution method from a plurality of methods including File Transport Protocol (FTP), E-mail, Hypertext Transfer Protocol (HTTP), Graphical User Interface (GUI), or other network transport mechanism (column 3, lines 42-51: service provider provide subscription-type message; column 2, lines 4-11: maintain and updating subscription among message service provider, message source partner and recipient users; column 6, lines 35-42: Web page, email).

Art Unit: 2144

- s. Regarding claim 19, Aoki disclosed a system as recited in claim 13, further comprising means for utilizing the database and processing mechanisms to conform to legal standards or best practices for e-mail marketing (column 5, lines 11-26: subscription database; line 40-column 6, line 3: double opt-out confirmation on canceling subscription; column 6, lines 35-42: subscription manager and associated database assures coordinated update, messaging among service provider, partner and subscriber).
- t. Regarding claim 20, Aoki disclosed a system as recited in claim 19, further comprising means to define or configure "legal standards" or "best practices" (column 6, lines 35-42: subscription manager and associated database assures coordinated update, messaging among service provider, partner and subscriber; line 40-column 6, line 3: double opt-out confirmation on canceling subscription).
- u. Regarding claim 21, Aoki disclosed a system as recited in claim 20, further comprising means for utilizing the database and processing mechanisms to modify, update, or delete opt-out or unsubscribe information (column 1, lines 58-63: maintain and update subscription database; column 7, lines 34-38: subscription cancellation form).
- v. Regarding claim 22, Aoki disclosed a system as recited in claim 20, further comprising means for utilizing the database and processing mechanisms for real-time "DO NOT E-MAIL" queries (column 5, lines 11-26: subscription database and rule database used in screening out unauthorized broadcast messages).

Art Unit: 2144

- w. Regarding claim 23, Aoki disclosed a system as recited in claim 20, further comprising means for utilizing the database and processing mechanisms to synchronize information with external sources of opt-out or unsubscribe information (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users).
- x. Regarding claim 24, Aoki disclosed a system as recited in claim 20, further comprising means for utilizing the database and processing mechanisms to synchronize information with external recipients of opt-out or unsubscribe information (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users).
- y. Regarding claim 25, Aoki disclosed a system as recited in claim 20, further comprising means for utilizing the database and processing mechanisms to collect, store, process and distribute opt-in or subscription information (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users; column 7, lines 34-38: subscription start form).

- z. Regarding claim 26, Aoki disclosed a system as recited in claim 20, further comprising means for utilizing the system for e-mail list "cleaning" of addresses to be removed (column 6, lines 35-42: subscription manager and associated database assures coordinated update, messaging among service provider, partner and subscriber; column 7, lines 34-38: subscription cancellation form).
- aa. Regarding claim 27, Aoki disclosed a computer program embodied on a computer readable medium for managing opt-out or unsubscribe information (Fig. 1, item 42; column 5, line 40-column 6, line 3: double opt-out confirmation on canceling subscription), the computer program code comprising: a code segment for collecting an e-mail address and contextual information for a user (column 5, lines 27-39: listing of approved message sources maintained for each individual destination user address along with predetermined parameters); a code segment for storing the e-mail address and contextual information in a database (column 5, lines 11-26: subscription database); a code segment for processing the e-mail address and contextual information for rule-based and learning-based use (column 4, lines 45-54: filter rules provided; 1st paragraph on page 7 of applicant's specification); and a code segment for distributing or sharing the e-mail address, contextual information, and derived processed data to an entity entitled to such information, at intervals or upon request (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating approved list; column 2, lines 4-11: maintain and updating subscription among message service provider, message source partner and recipient users; column 5, lines 27-39: controlled or periodically updated).

- bb. Regarding claim 28, Aoki disclosed a computer program as recited in claim 27, further comprising a code segment for collecting opt-out or unsubscribe e-mail information from a plurality of sources, including HTML form inputs, HTTP links, bulk text-file import, or other input mechanisms (column 6, lines 35-42: Web page, email).
- cc. Regarding claim 29, Aoki disclosed a computer program as recited in claim 27, further comprising a code segment to configure the means for collection of opt-out or unsubscribe e-mail information (column 6, lines 35-42: subscription manager and associated database automatically assures coordinated update, messaging among service provider, partner and subscriber).
- dd. Regarding claim 30, Aoki disclosed a computer program as recited in claim 27, further comprising a code segment to select a distribution method from a plurality of methods including File Transport Protocol (FTP), E-mail, Hypertext Transfer Protocol (HTTP), Graphical User Interface (GUI), or other network transport mechanism (column 3, lines 42-51: service provider provide subscription-type message; column 2, lines 4-11: maintain and updating subscription among message service provider, message source partner and recipient users; column 6, lines 35-42: Web page, email).
- ee. Regarding claim 31, Aoki disclosed a computer program as recited in claim 27, further comprising a code segment for utilizing the database and processing mechanisms to conform to legal standards or best practices for e-mail marketing (column 5, lines 11-26: subscription database; line 40-column 6, line 3: double opt-

out confirmation on canceling subscription; column 6, lines 35-42: subscription manager and associated database assures coordinated update, messaging among service provider, partner and subscriber).

ff. Regarding claim 32, Aoki disclosed a computer program as recited in claim 31, further comprising a code segment to define or configure "legal standards" or "best practices" (column 6, lines 35-42: subscription manager and associated database assures coordinated update, messaging among service provider, partner and subscriber; line 40-column 6, line 3: double opt-out confirmation on canceling subscription).

gg. Regarding claim 33, Aoki disclosed a computer program as recited in claim 27, further comprising a code segment for utilizing the database and processing mechanisms to modify, update, or delete opt-out or unsubscribe information (column 1, lines 58-63: maintain and update subscription database; column 7, lines 34-38: subscription cancellation form).

hh. Regarding claim 34, Aoki disclosed a computer program as recited in claim 27, further comprising a code segment for utilizing the database and processing mechanisms for real-time "DO NOT E-MAIL" queries (column 5, lines 11-26: subscription database and rule database used in screening out unauthorized broadcast messages).

ii. Regarding claim 35, Aoki disclosed a computer program as recited in claim 27, further comprising a code segment for utilizing the database and processing mechanisms to synchronize information with external sources of opt-out or

Art Unit: 2144

unsubscribe information (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users).

- jj. Regarding claim 36, Aoki disclosed a computer program as recited in claim 27, further comprising a code segment for utilizing the database and processing mechanisms to synchronize information with external recipients of opt-out or unsubscribe information (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users).
- kk. Regarding claim 37, Aoki disclosed a computer program as recited in claim 27, further comprising a code segment for utilizing the database and processing mechanisms to collect, store, process and distribute opt-in or subscription information (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users; column 7, lines 34-38: subscription start form).
- ll. Regarding claim 38, Aoki disclosed a computer program as recited in claim 27, further comprising a code segment for utilizing the database and processing mechanisms for e-mail list "cleaning" of addresses to be removed (column 6, lines 35-42: subscription manager and associated database assures coordinated update,

messaging among service provider, partner and subscriber; column 7, lines 34-38:
subscription cancellation form).

Aoki disclosed all limitations of claims 1-38. Claims 1-38 are rejected under 35 U.S.C.
102(e).

Art Unit: 2144

Remarks

3. The following pertaining arts are discovered and not used in this office action. Office reserves the right to use these arts in later actions.
- a. Melet et al. (US 6615238 B1) Evolving interactive dialog box for an internet web page
 - b. Wachtel (US 6847974 B2) Method and apparatus for intelligent data assimilation
 - c. Carty et al. (US 7043497 B1) System and method for capturing and storing web site visitor profile information in a data warehouse
 - d. Seibel et al. (US 7043531 B1) Web-based customer lead generator system with preemptive profiling
 - e. Adler et al. (US 7069427 B2) Using a rules model to improve handling of personally identifiable information
 - f. Rounthwaite et al. (US 7219148 B2) Feedback loop for spam prevention
 - g. Spitz et al. (US 20030114157 A1) Systems, methods, and computer program products for registering wireless device users in direct marketing campaigns

Art Unit: 2144

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peling A Shaw
Patent Examiner
Art Unit 2144

pas